

REMARKS

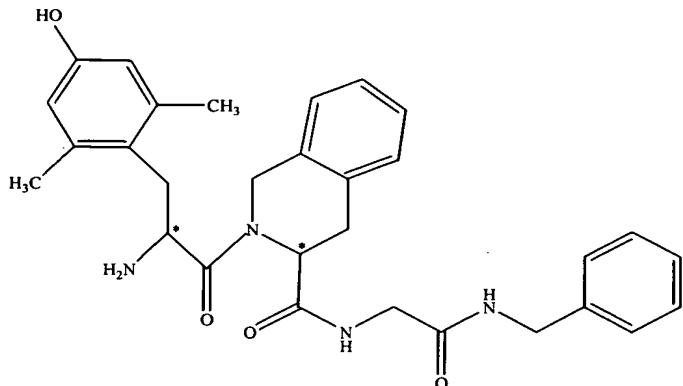
The Restriction Requirement and Election

The Office Action sets forth the following requirement for restriction:

- (I) claims 1-4 and 9, drawn to compounds; and
- (II) claims 5-8 and 10, drawn to methods of using compounds from Group I.

Applicants elect, with traverse, the claims of Group I, i.e., claims 1-4 and 9, for examination.

The Office Action also requests that applicants elect a species corresponding to the elected group. Applicants elect, with traverse, the species of the formula:



This species is disclosed in the specification at, for example, paragraphs [0017] and [0042]. Claims 1-4 and 9 of Group I read on the elected species. Applicants elect this species with the understanding that the election is for search purposes only, and upon allowance of a generic claim, applicants will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. § 1.141.

In regard to the group election, applicants respectfully submit that the claims of Groups II (i.e., claims 5-8 and 10) should be examined with the claims of Group I for the reasons set forth below.

Discussion

There are two criteria for a proper requirement for restriction between patentably distinct inventions: (i) the inventions must be independent or distinct as claimed, and (ii)

there must be a serious burden on the Examiner if restriction is not required. M.P.E.P. § 803. Consequently, as set forth in M.P.E.P. § 803: “If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.” In the case at hand, the Office has failed to meet the criteria for a proper restriction requirement by not even so much as asserting that there would be a serious burden on the Examiner if restriction were not required.

Moreover, as is also stated in M.P.E.P. § 803, mere assertions as to the requirements for restriction are insufficient; rather, “Examiners must provide reasons and/or examples to support conclusions.” Here, again, the Office only alleged that the inventions are distinct on the grounds that they are related as product and process of use, citing M.P.E.P. § 806.05(h). Yet, as required by M.P.E.P. § 806.05(h), mere allegation, without support, is insufficient to support a restriction requirement. Rather, “[t]he burden is on the examiner to provide an example ... the burden is on the examiner to support a viable alternative use or withdraw the requirement.” See, also, “Examiner Note,” 2. a) and 2. b), in M.P.E.P. § 806.05(h).

In addition, even if related inventions are shown to be distinct under the criteria of M.P.E.P. § 806.05 (c)-(i), “the examiner, in order to establish reasons for insisting upon restriction, must show by appropriate explanation one of the following: (1) separate classification thereof ... (2) a separate status in the art when they are classifiable together ... (3) a different field of search.” M.P.E.P. § 808.02. Here, the Office has failed to show by appropriate explanation separate classification, separate status in the art when classifiable together, or a different field of search.

Furthermore, the nature of the claims is such that references uncovered by the Office in a search of the claims of Group I would likely be considered by the Office in the examination of the claims of Group II and *vice versa*. For example, claims 5 and 8 of Group II recite the compounds of claims 1, 2, and 9 of Group I. In addition, claim 7 of Group II recites the compounds of claims 1 and 2 of Group I. The Examiner admits as much by stating, “in the event that Group I is elected, and claims therein found allowable, claims drawn to a method of using the allowable compounds will be rejoined for further examination” (see Office Action, page 2). This is *prima facie* evidence that there would be no undue burden on the Examiner. This does not mean that the claims necessarily stand and

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fall together, but, rather, that the overlapping relevance of references mitigates against a restriction requirement.

Conclusion

The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned representative.

Respectfully submitted,



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Date: April 26, 2004